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DEC 12 2006

OFFICE OF PETITIONS

In re Patent of Nagai et al. :
Patent No. 6,870,865 : DECISION ON REQUEST FOR
Issue Date: March 22, 2005 : RECONSIDERATION OF
Application No. 09/839,139 : PATENT TERM ADJUSTMENT
Filing Date: April 23, 2001 : and
Atty Docket No. 00862.022205 : NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision in response to the "Request for Reconsideration of Patent Term Adjustment Under 37 C.F.R. §1.705(d)" filed April 27, 2005, which in essence requests that the Patent Term Adjustment for the above-identified patent be increased to 150 days.

The request for reconsideration of the patent term adjustment indicated on the patent is **DISMISSED**.

Any response to this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are NOT permitted. Any response should include a cover letter entitled "Renewed Request under 37 CFR 1.705(d)." ."

For the reasons stated herein, the patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of zero (0) days.

The Determination of Patent Term Adjustment under 35 U.S.C. 154(b) mailed with the Notice of Allowance on August 13, 2004, stated the patent term adjustment to date was 68 days. The patent issued on March 22, 2005. The printed patent shows a patent term adjustment of 58 days.

The Office has conducted a review of the entire prosecution history. The review indicates the patented should have shown a patent term adjustment of zero (0) days.

It is undisputed that the reduction of 31 days pursuant to 37 CFR 1.704(b) is correct for patentee taking until April 17, 2003, three months and 31 days later, to respond to the non-final Office action mailed December 17, 2002.

A reduction of 19 days is proper pursuant to 37 CFR 1.704(b) which provides for a reduction in patent term when an applicant takes more than 3 months to respond to the Office action. A final Office action was mailed July 2, 2003. An RCE, request for extension of time, and amendment were filed 3 months and 19 days later on October 21, 2003.

A reduction of 63 days is proper pursuant to 37 CFR 1.704(c)(8) which provides for a reduction in patent term when an applicant files a supplemental reply or other paper after a reply has been filed. An RCE, request for extension of time, and amendment were filed on October 21, 2003. An IDS was filed 63 days later on December 23, 2003.

A reduction in patent term is appropriate for the "Second Request for Corrected Official Filing Receipt" and the "Third Request for Corrected Official Filing Receipt" which were filed after the mailing of the Notice of Allowance. 37 CFR 1.704(c)(10) states,

[Upon] [s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed ... the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months.

The Office has given examples of papers which not result in a reduction in term adjustment pursuant to 37 CFR 1.704(c)(10).¹ Requests for Corrected Official Filing Receipts are not among the examples. The second and third requests were in essence

¹ See Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance Has Been Mailed, 1247 OG 111 (June 26, 2001).

duplicates of the first request. The Office has recognized the filing of duplicate papers delays the issuance process. The Office has stated, "Duplicate filing of papers only cause delays and confusion, unless the duplicate has been specifically required by the Office."² The second and third Requests were also similar, in nature, to status inquiries since petitioner was essentially seeking the status of the originally filed Request for Corrected Official Filing Receipt. The Office has determined status inquiries filed after allowance should result in a reduction in patent term.³

The facts fail to indicate patentees could not have filed the second and third Requests prior to the mailing of the Notice of Allowance. The first Request for Corrected Filing Receipt was filed September 27, 2001. The request noted the Office had incorrectly entered the first name of an inventor as Yashiyuki rather than Yoshiyuki. Although the Office promptly corrected the name in Office records, the record fails to indicate a Corrected Filing Receipt was mailed.⁴ The second Request was not filed until almost three years after the first Request. Patentees had three years within which patentees could have ensured the spelling of the name had been corrected. For the reasons above, the Requests for Corrected Official Filing Receipt filed after allowance will result in a reduction in the patent term adjustment.

² *Patents to Issue More Quickly After Issue Fee Payment, Notice*, 1220 Off. Gaz. Pat. Office 42 (Mar. 9, 1999).

³ *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 56,366, 53,387 (September 18, 2000), 1239 Off. Gaz. Pat. Office 14 (October 3, 2000):

Papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait for payment of the issue fee to begin the process of preparing the application for publication as a patent. Section 1.704(c)(10) as adopted should deter applicants from filing papers after allowance which should have a beneficial impact upon the Office's ability to publish applications as patents more quickly.... In addition, a status inquiry filed after allowance may result in a reduction of the term adjustment. Applicants are encouraged to either call the Office or use the PAIR system (<http://pair.uspto.gov>) to monitor the status of an application rather than submitting written status inquiries.

Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704, 21709 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004), states,

[T]he PAIR system provides public access to PALM for patents and applications that have been published which can be accessed over the Internet (at <http://pair.uspto.gov>), and has a private side (<http://pairedirect.uspto.gov>) which may be used by an applicant to access confidential information about his or her pending application. See *id.* Thus, applicants who choose to file status letters rather than check the status of their applications via the PAIR system must accept the negative impact on patent term adjustment that will result from such a course of action.

⁴ The Office notes papers mailed by the Office on September 30, 2001, December 17, 2002, July 2, 2003, January 14, 2004, July 2, 2004, and August 13, 2004, listed the inventor's name with the proper spelling.

A reduction of 120 days is proper pursuant to 37 CFR 1.704(c)(10) for the "Second Request for Corrected Official Filing Receipt" filed September 8, 2004. The amount of the reduction is the lesser of the number of days beginning on September 8, 2004, and ending on the day a reply was mailed to the Second Request, or four months. Since a reply to the Second Request was not mailed within 120 days, a reduction in patent term adjustment of 120 days is appropriate.

The "Third Request for Corrected Official Filing Receipt" was filed March 7, 2005. The patent issued on March 22, 2005. Therefore, a reduction of 16 days is proper pursuant to 37 CFR 1.704(c)(10) for the Third Request.

A review of the record indicates a reduction in patent term is not warranted for the filing of drawings after the mailing of the notice of allowance. The record indicates that the Office made an error in scanning the original drawings. On December 21, 2004, the drawing sheet originally filed April 23, 2001 was rescanned into the application. Under the circumstances, it is concluded that there was no failure to engage by applicants.

The total reduction in time pursuant to 37 CFR 1.704(b) and 37 CFR 1.704(c) is 218 days (31 + 19 + 63 + 120 +16).

Patentees do not disagree with the Office's prior determination of a total of 181 days of Office delay pursuant to 37 CFR 1.703(a).

The patent term adjustment cannot be less than 0. Since subtracting 249 days of patentee delay from 181 days of PTO delay would result in a negative number of days, the patent term adjustment is 0 days.

As shown above, the record has been reconsidered, and it has been determined that the period of adjustment on the patent should have been zero (0) days.

Further correspondence with respect to this matter should be addressed as follows:

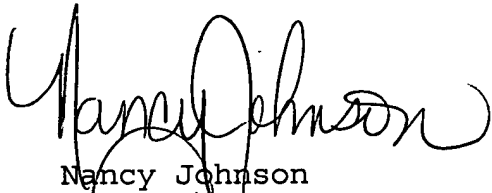
By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The Certificates of Correction Branch will issue a certificate of correction in order to rectify the error regarding the patent term information. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by ZERO (0) days subject to any disclaimers.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized initial "N" and a long, sweeping underline.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

PATENT NO. : 6,870,865 B1
APPLICATION NO.: 09/839,139
ISSUE DATE : March 22, 2005
INVENTOR(S) : Nagai et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (58) days

Delete the phrase "by (58) days" and insert -- by (0) days--